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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/950,902	10/15/1997	YOSHIHIDE HAGIWARA	S-2418	9924

7590 06/18/2002

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EXAMINER	
SHERRER, CURTIS EDWARD	
ART UNIT	PAPER NUMBER
1761	27

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

GL

Office Action Summary

Application No.	Applicant(s)
08/950,902	Hagiwara
Examiner	**Art Unit**
Curtis E. Sherrer	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 22, 2002* .

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-4 and 10-15* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-4 and 10-15* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Part III DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-4, 10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papazian in view of Rizzi *et al.* (U.S. Pat. No. 5,329,708)(hereinafter Rizzi) for the reasons set forth in the last Office Action.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papazian in view of Rizzi and in further view of Suzuki (U.S. Pat. No. 3,845,220) for the reasons set forth in the last Office Action.

Response to Arguments

4. Applicant's arguments filed 04/22/02 have been fully considered but they are not persuasive.

5. Applicant argues that "there fails to be any adequate basis for a motivation to one skilled in the art to combine the references leading to their combination as relied on by the Examiner." In Paper # 7, ¶ 15, the examiner cited to *In re Levin* for motivational support. Applicant states that *In re Levin* is not applicable case law because the case law does not discuss the claimed

invention. *In re Levin* states that those in the food art will combine common food ingredients . Rizzi teaches that coffee residues are common food ingredients and therefore those in the food art would use such said residues to produce a food ingredient.

6. Applicant states that Papazian, the primary reference, teaches away from the combining the teaching of Rizzi because "Papazian uses the highest quality coffee beans in his brewing process . . . ." From reading Papazian it appears that using "only freshly ground beans" is merely a preference. It is noted that the disclosure refers to using decaffeinated coffee and this does not come from ground beans. Therefore, it does not appear that Papazian is limited to only the highest quality coffee beans.

7. Applicant refers to the processes found in the examples for producing his spent grounds. If this process is critical for producing the grounds, then said processes should be claimed in the dependent claim. Applicant also asserts that the instant fermentation process in which "the ingredients are changed to produce a product which is materially different from the properties which the several ingredients individually do no possess in common." It is not clear where specificational support is found for this assertion and therefore it is given no patentable weight.

8. Applicant argues that the obviousness rejection based on the Suzuki patent is improper because the patent teaches the use of the enzyme to modify the foaming properties of a coffee beverage and this is not relevant to the process taught by Papazian. In response, it is considered that the patent's teaching are relevant to the teachings of Papazian in view of Rizzi. Further, the product of Papazian is carbonated, i.e., coffee beer.

Conclusion

9. No claim is allowed.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Boniello *et al.* (USPN 4,867,992) teach the use of spent coffee hydrolyzates to produce a coffee flavoring via fermentation. See col. 2, lines 57-68).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

13. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Curtis E. Sherrer
Primary Examiner
June 17, 2002